

141. The method of claim 136 wherein the issued digital license includes a description of the rights conferred by the license, and further comprising:

evaluating, by a trusted license evaluator of the DRM system, the rights description; and

allowing rendering of the digital content by the rendering application only if such rendering is in accordance with the rights description of the license.

142. The method of claim 126 further comprising maintaining information on digital licenses issued by the license server in an issued license database, wherein if the computing device loses a received license, a re-issue thereof may be provided based on the information in the issued license database.

#### REMARKS

Claims 1-142 are pending in the present application. Claims 1-105 stand rejected according to the coversheet of the Office Action. New claims 106-142 have been added to further recite the subject matter of the present invention. None of claims 1-105 have been amended in response to the Office Action, and accordingly any subsequent Office Action should not be made final. Applicants respectfully submit that no new matter has been added to the application by the amendment.

The Examiner notes that corrections to the drawings are required as indicated by the Notice of Draftsperson's Patent Drawing Review (Form PTO-948) attached to the Office Action. Applicants will provide corrected formal drawings upon issuance of a Notice of Allowability.

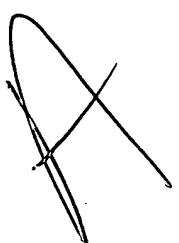
The Examiner has rejected claims 1-29 and 56-105 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. According to the Examiner, the rejected claims set forth means plus function limitations without corresponding disclosure of specific structures or materials in the specification. Applicants respectfully traverse the §112, second paragraph rejection.

The Examiner notes that independent claims 1, 56, and 83 each recite several elements that perform a specific function, and concludes that each such element is a means-plus-function element. Applicants respectfully disagree and submit that the claims are not subject to paragraph 6 of § 112 As noted in MPEP § 2181, a claim element that does not include the phrase "means for" or "step for" will not be considered by the PTO to invoke 35 USC § 112, sixth paragraph. Accordingly, since none of the elements recited in independent claims 1, 56, or 83 employs the phrase "means for", Applicants submit that such elements are not properly interpreted as means plus function elements under § 112, sixth paragraph.

Applicants respectfully point out that each and every element recited in independent claims 1, 56, and 83 is supported in the specification by disclosures of

specific structures or materials. For example, the content server recited in independent claims 1, 56, and 83 is structurally disclosed in the specification in connection with the discussion of Fig. 1, the license server of independent 1, 56, and 83 is disclosed in the specification in connection with Figs. 1 and 7, the computing device recited in claims 1 and 56 is disclosed in the specification in connection with Figs. 1, 4, 5A, 5B, 6, and 10, the digital rights management system of claims 1 and 56 is disclosed in the specification in connection with Figs. 4, 5A, 5B, 6, 7, 9, 10, and 11, and the authoring tool of claim 83 is disclosed in the specification in connection with Figs. 1 and 2. Moreover, block diagrams and flowcharts such as that shown in the drawings of the present application are sufficient to satisfy paragraphs 2 and 6 of § 112. See, for example, Fonar Corp. v. General Electric Co., 107 F.3d 1543, 41 USPQ2d 1801 (Fed. Cir. 1997).

Further, Applicants submit that the actual physical structure corresponding to such block diagrams is either known or would be apparent to those skilled in the relevant art based on the functional requirements of such structure as set forth in the specification and drawings of the present application. Likewise, the functionality of such software is disclosed in detail in the disclosure of the present application, especially in connection with the flowcharts of Figures 5A, 5B, 6, 7, 9, and 10. The programming necessary to effectuate the processes performed in connection with the present invention would be relatively straight-forward and would be apparent to those skilled in the relevant art. Accordingly, Applicants submit that such programming need

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not have been specifically disclosed in order to provide structural support for the elements recited in the claims of the present application.

Thus, and for all the aforementioned reasons, Applicants respectfully submit that independent claims 1, 56, and 83 do not employ means-plus-function limitations, and that the specification of the present application provides sufficient disclosure of specific structures or materials in order to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. As a result, Applicants respectfully request reconsideration and withdrawal of the § 112, second paragraph rejection.

The Examiner has specifically rejected claims 56-82 of the present application under 35 USC § 103(a) as being obvious over Stefik (U.S. Patent No. 5,715,403) in view of Rabne et al. (U.S. Patent No. 6,006,332), and further in view of Shear et al. (U.S. Patent No. 6,112,181) and further in view of "the Official Notice". Applicants respectfully traverse the § 103(a) rejection of claims 56-82.

Applicants respectfully submit that they are unable to fully respond to the § 103(a) rejection inasmuch as Applicants do not clearly understand the bases of the rejection of the claims under § 103(a). In particular, in the Office Action at page 4, number 7, claims 56-82 are specifically rejected under § 103(a), yet at number 6 on the same page, the Examiner ambiguously appears to 'wish' to extend the § 103(a) rejection of number 7 to claims 1-55 and 83-105. A fair reading of number 6, though, does not provide Applicants with enough information to determine whether such claims

1-55 and 83-105 are actually rejected or might be rejected on the same basis as with respect to claims 56-82, especially since the Examiner speaks of what he 'would have' done.

Moreover, Applicants respectfully submit that the Examiner does not specifically address many of such claims 1-55 and 83-105, except in a very abbreviated form at page 18 of the Office Action, and does not specifically address independent claims 1 or 83 at all. If claim 1-55 and 83-105 are not rejected, Applicants presume that such claims are allowable over the prior art and respectfully request a positive indication of such allowability. However, if such claims are to be rejected, Applicants respectfully request a positive indication of such rejection and also note that piece-meal examination of an application is frowned upon by MPEP 707.07(g). Under the circumstances, then, Applicants limit their remarks in response to the § 103(a) rejection to claims 56-82, inasmuch as comments regarding any of the other claims (1-55 and 83-105) could be unnecessarily construed as creating prosecution history estoppel with regard to such other claims.

Applicants also do not clearly understand the bases of the rejection of the claims under § 103(a) inasmuch as the citation of "the Official Notice" at page 4, number 7 of the Office Action as a reference for rejecting claims 56-82 is ambiguous and imprecise. In particular, Applicants are unsure as to what "the Official Notice" is, or is referring to, at least with regard to claims 56 and 58-82. The Examiner does take Official Notice at page 7 of the Office Action with regard to claim 57, but not with regard

to any other claims. Parenthetically, in taking such Official Notice with regard to claim 57, the Examiner cites to an unidentifiable 'Smith' reference, not mentioned anywhere else in the Office Action. Applicants respectfully submit that they are unable to respond to the rejection of claims 56 and 58-82 until the Examiner more clearly specifies the citation to the Official Notice with regard to such claims 56 and 58-82, and are unable to respond to the rejection of claim 57 until the Examiner more clearly specifies the citation to the 'Smith' reference.

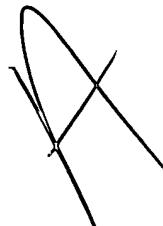
At any rate, and leaving aside for the moment the ambiguous citation of "the Official Notice" as a reference, claim 56 recites an enforcement architecture for digital rights management, where the architecture enforces rights in protected digital content. In the architecture, a content server, a license server and a computing device are all communicatively coupled to a network. The content server distributes digital content over the network, and the license server issues at least one digital license over the network. Importantly, the issued digital license corresponds to and is separate from the digital content.

The computing device receives the digital content and any digital license corresponding to the digital content. The computing device has a memory for storing the digital license corresponding to the digital content, and a rendering application for attempting to render the digital content. The computing device also has a digital rights management (DRM) system for being invoked by the rendering application upon the rendering application attempting to render the digital content. The DRM system

determines whether a right to render the digital content in the manner sought exists based on any digital license stored in the computing device, where such digital license corresponds to the digital content.

The Stefik reference discloses a system for controlling use and distribution of digital works. The system is exemplified by multiple repositories wherein the digital works are stored and accessed from such repositories, and are transferred only between such repositories. Each repository is a trusted system and can operate in a requestor mode for requesting a digital work from another repository and a server mode for responding to a request from another repository. Importantly, and as disclosed beginning at column 9, line 20, usage rights (i.e., license terms) are attached to digital works in the Stefik system, and both the work and its attached rights are transmitted from a serving repository (at a content provider, e.g.) to a requesting repository (at a client, e.g.). See also Fig. 1 and column 7, lines 16-48. Accordingly, the Stefik reference does not disclose or suggest a content server that issues content and a license server separate from the content server that issues a digital license corresponding to the digital content, as required by independent claim 56.

The Examiner goes on at some length in describing how the Stefik reference discloses a license server that issues a license over a network. However, the Examiner's recitation is actually to a portion of the background section of the Stefik reference, wherein a prior art PCT publication (WO 93/015502 to Griswold), discloses a centralized license control system. Such centralized license control system forms no

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part of the Stefik reference, and the Stefik reference in fact teaches that the centralized license control system of the Griswold reference is undesirable.

With regard to the Rabne and Shear references, the Examiner states only that the Rabne reference is "about a rights management system for digital media" and that the Shear reference is "about systems and methods for matching, selecting, narrow casting, and classifying based on rights management". The Examiner provides no further analysis of such Rabne or Shear references as they may be applied to independent claim 56 in particular and as may be helpful to the Applicants in clearly understanding the rejection of claims 56-82 based on such Rabne and Shear references.

The Examiner submits that all the claimed limitations of claim 56 are well-known in the art, and specifically states at page 6 of the Office Action that:

"cited prior art's limitations are not necessary (sic) spelled-out exactly claimed languages, (sic) because these prior references are also directed to a similar system/method for digital rights management. Cited prior arts (sic) are not limited to the described embodiments in these disclosures. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention."

(underlining included).

Accordingly, Applicants suspect but are unsure that the Examiner cites to the Rabne or Shear references only as background material with respect to the Stefik reference and thus as showing the general state of the relevant prior art. If so,

Applicants respectfully submit that such Rabne and Shear references need not be specifically addressed. If not, Applicants respectfully request that the Examiner more particularly point out how the Rabne and Shear references should be applied in the context of the present § 103(a) rejection of independent claim 56 in particular and claims 57-82 in general. Otherwise, Applicants respectfully submit that they are unable to respond to the § 103(a) rejection with regard to such Rabne and Shear references. Although Applicants could perhaps guess as to a specific manner in which the Examiner intends that such Rabne and Shear references are applicable, Applicants respectfully submit that such guessing would be a disservice to both Applicants and the PTO and is at any rate not required of Applicants.

The Examiner has cited to the submitted IDS (at page 6 of the Office Action) and to numerous other references not specifically employed to reject the claims (at page 8 of the Office Action) as a basis for concluding that the limitations recited in independent claim 56 and dependent claims 57 and 58 are well-known in the art. However, Applicants respectfully submit that they are unclear as to whether such citations require a response or are more generally indicative of the general state of the relevant art and therefore do not require a response, and respectfully request that the Examiner provide an indication thereof.

Applicants respectfully submit that based on all of the above reasons, the Examiner has not clearly set forth an explanation of the manner in which the Stefik reference should or could be modified in view of the Rabne and Shear references and

the Official Notice to produce the invention recited in claims 56-82. Moreover, without such explanation of how the references are applicable to the claims, Applicants respectfully submit that they are unable to fully and completely respond to the rejection in the manner in which they would like to do so.

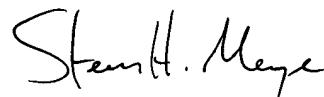
Accordingly, and for all of the aforementioned reasons, Applicants respectfully submit that the Examiner has not made a prima facie showing that the combination of the Stefik, Rabne, and Shear references, as set forth by the Examiner, makes obvious independent claim 56 or any claims depending therefrom, including claims 57-82. Applicants also respectfully submit that at any rate the combination of the Stefik, Rabne, and Shear references, as set forth by the Examiner, do not in fact make obvious independent claim 56 or any claims depending therefrom, including claims 57-82. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection.

Applicants note that in the conclusion to the Office action at pages 22-27, the Examiner cites numerous statements of case law in the area of patent law. However, such statements of law are cited without being applied to any specific rejection or claim. Applicants respectfully submit that the purpose of such statements of law is therefore unclear. Thus, Applicants respectfully request that the Examiner provide a positive indication of the application of each citation to the rejections set forth in the Office Action.

In view of the foregoing amendment and discussion, Applicant respectfully submits that the present application, including claims 1-142, is in condition for allowance, and such action is respectfully requested. Should the Examiner disagree, Applicants respectfully request that the Examiner telephone the undersigned at the number below to arrange an in-person interview with the Examiner and the Examiner's supervisor to discuss the present Office Action.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Respectfully submitted,



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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Claims:**

Claims 106-142 have been added.